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EXAMINER

NILFOROUSH, MOHAMMAD A

ART UNIT	PAPER NUMBER
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3685

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,819	Applicant(s) VITYAZ, OLEXANDR	
	Examiner Mohammad A. Nilforoush	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The amendment filed 21 January 2009 is acknowledged.
2. Claims 1-2 are pending.
3. Claims 1-2 have been examined.
4. This Office action is given Paper No. 20090408 for reference purposes only.

Response to Amendment/Arguments

5. The amendment of claims 1 and 2 adds limitations that do not serve to differentiate the claims from the prior art.
6. Specifically, claim 1 now recites "...obtaining additional user data *if* they are necessary for registration at the respective server unit...", "...verifying...absence of data for refusal of registration and, *in case of their absence*, generating at least one set of code symbols...", and "...sending the refusal of the user's registration...*in case of there being a reason to refuse* registration..." Claim 2 further recites "...*if there is an absence of data for refusal of registration* at least one set of code symbols is transmitted...followed by displaying said set of code symbols on a monitor and/or printing on paper..." Thus, "obtaining additional user data" is conditional on the data being necessary for registration, "generating at least one set of code symbols" is conditional on the absence of data for refusal of registration, "sending the refusal of the user's registration" is conditional on there being a reason to refuse, and transmission and display and/or printing of the code symbols is conditional on an absence of data for

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refusal of registration. Therefore, these steps are only performed when the condition is met. As they are not necessarily performed, they do not serve to differentiate the claims from the prior art. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally performed under certain other hypothetical scenarios. (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C).

7. Applicant's arguments filed 21 January 2009 have been fully considered but they are not persuasive.

8. It is the Applicant's position that "...gateway server 16 is not a server unit (third party or bank's affiliated entity) that provides remote service with direct user requesting (including user's identification by the respective server of the registered users' database)."

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the server unit providing remote service with direct user requesting) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. The remainder of Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite "...generating a request to the proxy's processing center..." in lines 8-9 of the claim. Neither the specification nor the original set of claims mention a proxy having a processing center separate from the "bank's processing center". The only "processing center" mentioned in the specification is the "bank's processing center".

Claim 2 is also rejected as it depends on claim 1.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 1 recites the limitation "the number of banking or financial user car serving terminals (UCST)" in lines 3-5 of the claim. Claim 1 further recites the limitation "the

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personal identification number (PIN) of the card” in line 6 of the claim, “the number of accessible remote server units” in line 7 of the claim, “the proxy’s processing center in line 9 of the claim, “the bank card issuer” in line 11 of the claim, “the type of selected service” in line 11 of the claim, “the bank account of the user” in line 12 of the claim, “the availability” in line 14 of the claim, “the bank’s processing center” in line 17 of the claim, “the user registration control bank server” in lines 17-18 of the claim, and “the registered users’ databases” in line 22 of the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 2 is also rejected as it depends on claim 1.

16. Claim 1 recites “...recording of the type of selected service and amount of money for the registration *withdrawn* from the bank account of the user...” However, claim 1 later recites “...verification of the availability and status of the user's account is performed, *followed by withdrawal of money for registration/re-registration...*” It is unclear to one of ordinary skill how the processing center can record the amount of money withdrawn from the bank account of the user before any withdrawal of money has occurred. For purposes of examination, the claim is interpreted as reciting “...recording of the type of selected service and amount of money for the registration *to be withdrawn* from the bank account of the user...”

Claim 2 is also rejected as it depends on claim 1.

17. Claim 1 further recites “...generating at least one set of code symbols, that is transmitted to a respective server of the registered users' databases at least one of the respective server units selected by the user...” It is unclear to one of ordinary skill

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whether the set of code symbols are transmitted to a respective server that is part of the registered users' databases or to a registered users' database on the respective server. Also, in case the set of code symbols is transmitted to a respective server that is part of the registered users' databases, it is unclear to one of ordinary skill how a server can be part of a database. For purposes of examination, this limitation was interpreted as the set of code symbols being transmitted to a respective server.

Claim 2 is also rejected as it depends on claim 1.

18. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fieldhouse (US Patent Application Publication No. 2003/0037000) in view of Nagy et al. (US Patent Application Publication No. 2003/0119478, hereinafter "Nagy").

21. Regarding claim 1, Fieldhouse discloses a method for user registration with a proxy for further work with a server unit comprising:

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- requesting the proxy via one of the number of banking or financial user card serving terminals (UCST) including the steps of inserting a user card and entering the personal identification number (PIN) of the card and selecting the necessary service out of the number of accessible remote server units (Fieldhouse Paragraphs **18-22**);
- verifying by the user card serving terminal (UCST) the card's PIN followed by generating a request to the proxy's processing center (Fieldhouse Paragraphs **12, 19, and 22**);
- determining by the processing center the card belonging to a certain payment system followed by identifying the bank card issuer, recording of the type of selected service and amount of money for the registration to be withdrawn from the bank account of the user (Fieldhouse Paragraphs **12, 23-24, 28-33**);
- performing at the processing center, verification of the availability and status of the user's account, followed by withdrawal of money for registration/re-registration (Fieldhouse Paragraph **32**) and obtaining additional user data if they are necessary for registration at the respective server unit (Fieldhouse Paragraph **23**, bank account number);
- sending by the processing center data to the user registration control server which are necessary for registration of the user with the respective server unit (Fieldhouse Paragraphs **22 and 33-34**).
- verifying by the user registration control server absence of data for refusal of registration and, in case of their absence, registering the user in the respective

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server and generating a notification that the registration was successful

(Fieldhouse Paragraphs **24-27** and **33-37**).

- transmitting by the user registration control server said notification via the bank's processing center to a respective banking or financial user card serving terminal (UCST) for the user and for further user's identification at respective server unit (Fieldhouse Paragraphs **25-27** and **35-37**);

Fieldhouse does not specifically disclose that the bank's system comprises a separate processing center, a user registration control bank server, and a bank's issued card database and the request is routed by said processing center to the bank's issued card database server (BICD) of respective identified bank card issuer. Fieldhouse further does not specifically disclose the user registration control server generating at least one set of code symbols, and that this set of code symbols is transmitted to a respective server and the respective banking or financial user card serving terminal. Fieldhouse also does not specifically disclose sending the refusal of the user's registration by the user registration control bank server via the bank's processing center to the respective banking or financial user card serving terminal in case of there being a reason to refuse registration with a respective servers of the registered users' databases.

Nagy discloses providing an ATM user a means to enroll in a mobile payments service at the ATM (Nagy Paragraphs **72-73**). The system then generates or allows the user to select a mobile PIN which is presented to the user at the ATM (Nagy Paragraph

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73). Also, Nagy discloses providing a "Failed Enrollment" message if their enrollment is refused (Nagy Paragraphs **48**, **51-53**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Fieldhouse to include generating code symbols for an enrolled user and presenting it to the user at an ATM, or presenting the user with an error message if enrollment failed, as disclosed in Nagy, in order to allow customers to refill their prepaid telephone at many locations, including ATMs (Nagy Paragraphs **5** and **10**). Regarding the separation of the bank's system into multiple components, it would have been obvious to one ordinary skill in the art at the time of the invention to separate the functionality of a bank's computer system into a separate processing center, a user registration control bank server, and a bank's issued card database as it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (*In re Dulberg*, 129 USPQ 348, (CCPA 1961)).

22. Regarding claim 2 Nagy discloses that if there is an absence of data for refusal of registration at least one set of code symbols is transmitted by the user registration control bank server via the bank's processing center to the respective banking or financial user card serving terminal (UCST) followed by displaying said set of code symbols on a monitor and/or printing on paper (bill/receipt) for the user and for further user's identification at respective server unit (Nagy Paragraph **73**).

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Nilforoush whose telephone number is (571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. N./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685